

Appl. No. : 10/671,179
Filed : September 25, 2003

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Summary Of Interview

Date:

September 11, 2006

Attendees:

Examiner Winakur

Examiner Berhanu

John M. Grover, Reg. No. 42,610

Jarom D. Kesler, Reg. No. 57,046

Prior Art Discussed:

U.S. Pat. No. 5,842,979

Matters Discussed:

Proposed amendments to the claims were discussed in light of the prior art of record.

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REMARKS

The Applicants thank the Examiner for her careful and thoughtful examination of the present application. By way of summary, Claims 1-12 were pending in this application. In the present amendment, the Applicants have amended Claims 2-4, 6-10, and 12 and added New Claims 13-20. Accordingly, Claims 2-20 remain pending for consideration.

The Applicants would like to thank Examiner Winakur and Examiner Berhanou for the interview extended to the Applicants' counsel of record, John M. Grover and Jarom D. Kesler, on September 11, 2006. During the interview, the Applicants and Examiners discussed proposed amendments to the claims and the prior art of record. Accordingly, the Applicants have taken into account the discussion of the interview in amending Claims 2-4, 6-10, and 12 and adding New Claims 13-20. Therefore, the Applicants respectfully request reconsideration of the pending amended claims.

Provisional Rejection Of Claims 2-6, 9 and 11-12 For Obviousness-Type Double Patenting

The Office Action rejected Claims 2-6, 9 and 11-12 under the non-statutory, obviousness-type double patenting. While the Applicants may not agree with the foregoing rejection, in order to progress the prosecution of the present application, the Applicants have attached an appropriate Terminal Disclaimer. Accordingly, the Applicants respectfully request withdrawal of the provisional non-statutory, obviousness-type double patenting rejection of the claims.

Objections To Claim 2

The Office Action objected to Claim 2 for minor informalities. In particular, the Office Action stated that the word "responsive" in line 6 should be omitted. In response, the Applicants have omitted the word "responsive" from Claim 2. Accordingly, the Applicants respectfully request withdrawal of the objection to the claims.

Rejection Of Claims 6-10 Under 35 U.S.C. § 112, Second Paragraph

The Office Action rejected Claims 6-10 under 35 U.S.C. § 112, ¶ 2, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter for which applicant regards as the invention. Specifically, the Office Action objected to the phrase "said first internal property" in Claim 6 and "said second internal property" in Claims 7-10 as lacking antecedent basis. The Applicants have amended these claims to recite "said first physiological properties" and "said second physiological properties" respectively. Antecedent basis for these

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phrases can be found in Claim 4. Accordingly, the Applicants respectfully request withdrawal of the § 112, ¶ 2 rejection of Claims 6-10.

Rejection Of Claim 2 Under 35 U.S.C. § 101

The Office Action rejected Claim 2 under 35 U.S.C. § 101, as allegedly being directed toward non-statutory subject matter. The Applicants do not agree that claim 2 is directed toward non-statutory subject matter. Claimed subject matter which produces a "useful, concrete and tangible result" is patentable. *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. 1998); see also MPEP 2106(II)(A). "The purpose of this requirement is to limit patent protection to inventions that possess a certain level of 'real world' value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for further investigation or research." MPEP 2106(II)(A); *Brenner v. Manson*, 383 U.S. 519, 528-36 (1966). Claim 2 recites among other things, reading a primary input in communication with a first device responsive to a first biological property and reading a parameter input in communication with a second device responsive to a second biological property, processing the primary input and the parameter input to output a compensated measurement and causing the output to be displayed. Claim 2 produces a useful, concrete, tangible, and real world result. Accordingly, the Applicants respectfully request withdrawal of the § 101 rejection.

Rejection Of Claims 2-6 and 9-12 Under 35 U.S.C. § 102(b)

The Office Action rejected Claims 2-6 and 9-12 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 5,842,979, issued to Jarman, (the Jarman patent). The Applicants respectfully submit that the claims as previously pending are patentably distinguished over the Jarman patent, the other cited references, or any combination thereof. Claims 2-4, however, have been amended in order to clarify the features of the Applicants' inventions. Amended independent Claims 2-4 recite among other things: "wherein said first device comprises an optical device and said second device comprises a non-optical device." Jarman fails to disclose or suggest communicating with a first device comprising an optical device and a second device comprising a non-optical device. Thus, the Jarman patent fails to identically teach every element of Claims 2-4. Accordingly, Applicants respectfully submit that Claims 2-4 are in condition for allowance over the cited art of record.

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Claims 5, 6 and 9-12 which depend from Claim 4, are believed to be patentable for the same reasons articulated above with respect to Claim 4, and because of the additional features recited therein.

Rejection Of Claims 4 and 7 Under 35 U.S.C. § 102(b)

The Office Action rejected Claims 4 and 7 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 5,190,039, issued to Takeuchi et al., (the Takeuchi patent). The Office Action stated that "no weight was given to lines 7-8 'a compensation relationship of said primary input, said parameter input and a compensated measurement;' because it is not part of the structure of the monitor and therefore fail to further limit the structure of the monitor." These claim amendments are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Applicants therefore respectfully submit that Claim 4 is in position for allowance, and requests such action.

Claim 7, which depends from Claim 4, is believed to be patentable for the same reasons articulated above with respect to Claim 4, and because of the additional features recited therein.

Rejection Of Claims 4 and 8 Under 35 U.S.C. § 102(b)

The Office Action rejected Claims 4 and 8 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 5,372,136, issued to Steuer et al., (the Steuer patent). The Office Action stated that "no weight was given to lines 7-8 'a compensation relationship of said primary input, said parameter input and a compensated measurement;' because it is not part of the structure of the monitor and therefore fail to further limit the structure of the monitor." Applicants respectfully disagree with this conclusion. "A claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *In re Lowry*, 32 F.3d 1579, 1585-84 (Fed. Cir. 1994); MPEP 2601.1 (i). "When evaluating the scope of a claim, every limitation in the claim must be considered." MPEP 2144.08, see also, *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Amended Claim 4 discloses among other things, "a processor configured to output said compensated measurement from said primary input and said parameter input utilizing a compensation relationship between said primary input and said parameter input." Applicants

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respectfully submit that weight should be given to the compensation relationship as it defines structural and functional interrelationships between the processor and the rest of the claimed subject matter. The claim amendments made to Claim 4 through this office action are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Applicants therefore respectfully submit that Claim 4 is in position for allowance, and requests such action.

Claim 8, which depends from Claim 4, is believed to be patentable for the same reasons articulated above with respect to Claim 4, and because of the additional features recited therein.

New Claims

New Claims 13-20 have been added to more fully define the Applicant's invention and are believed to be fully distinguished over the prior art of record.

Request For Telephone Interview

In view of the forgoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Applicants' undersigned attorney of record hereby formally requests a telephone interview with the Examiner. The Applicants' attorney can be reached at (949) 721-2923 or at the number listed below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: NOV 20, 2006

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